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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,737	12/12/2001	Mitchell T. Weisman	10005.000200	1057

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EXAMINER

BEKERMANN, MICHAEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,737

Applicant(s)

WEISMAN ET AL.

Examiner

Michael Bekerman

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/26/02, 1/27/03, 2/19/03, 4/18/03, 9/22/03
1/16/04, 6/1/04, 5/10/06, 5/30/06, 6/2/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

DETAILED ACTION

Specification

1. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claim 7, no structure is claimed in this computer claim, only programming. Since a computer is a physical object, structure is expected. This makes the claim unclear.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 7 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 7, this claim appears to be programming per se, which is not statutory. If the preamble set forth such computer executable instructions on the structure of a computer readable medium, then the claim would appear to be statutory. Please reference MPEP 2106 (IV) (B) (1) (a) for the basis of this rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-10, and 12-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Fuller (U.S. Patent No. 6,216,112). Fuller teaches an adware program that includes all of the limitations recited in the above claims.

Regarding claims 1-4, 7-9, 14, 15, and 20-22, Fuller teaches making adware software and an accompanying plug-in (member items) available over a computer network, downloading the software and plug-in combination to a computer (Column 3, Lines 19-22), and delivering advertising to the computer (advertising updates are software packets considered to be in the same group as the original downloaded

software, and are therefore additional member items) even if the original software is not being executed (a web browser connects to the internet to download [deliver] advertisement updates) (Column 3, Lines 47-57). If the plug-in module that downloads the advertisements is uninstalled from the system, no further advertisement updates will be downloaded.

Regarding claims 5 and 10, Fuller teaches a list of adware programs that are downloaded onto the user computer (Column 11, Lines 7-9).

Regarding claim 6, 13, and 16-18, Fuller teaches users going to a web page (server) and choosing which software they want (Column 3, Lines 19-22). Fuller also teaches different advertisements being combined with different software (Column 7, Lines 53-54). Thus, this reads on advertising that is selected based on a web page viewed by a user. Since every business inherently has a competitor, the server hosting the software is considered to be a "competitor of a company", and the advertising is delivered on behalf of the server (competitor) webpage.

Regarding claim 12, Fuller's advertising is targeted towards people who download the adware software.

Regarding claim 19, the terms "competitor" and "same type" are very broad. Any product may be interpreted as a competitor of another product. Fuller teaches advertising provided on behalf of a company.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fuller (U.S. Patent No. 6,216,112).**

Regarding claim 12, Fuller doesn't specify an advertisement as being delivered via pop-up. Official notice is taken that it is old and well known to display advertisements on a computer via pop-ups. It would have been obvious to one having ordinary skill in the art at the time the invention was made to display the advertisement in a pop-up window. This feature would help to draw the user's attention towards the advertisement.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to adware programs:

U.S. Patent No. 5,848,397 to Marsh

U.S. Patent No. 6,141,010 to Hoyle

U.S. Pub No. 2001/0034762 to Jacobs


U.S. Pub No. 2005/0086112 to Shkedi

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JEFFREY D. CARLSON
PRIMARY EXAMINER